

S.N. 10/796,814

Art Unit 1742

## REMARKS:

Claims 1-3 are pending.

Citing the parent case (now U.S. Patent No. 5,591,317, hereinafter the '317 Patent) of the present application, the Examiner has finally rejected all claims under 35 U.S.C. 102(b). The Examiner essentially takes the position that, on the one hand, the '317 Patent inherently discloses a method for reducing the formation of biofilm deposits for prior art purposes, yet, on the other hand, does not inherently disclose a method for reducing the formation of biofilm deposits for priority purposes (paragraphs 4 and 5 of the present Office Action).

While continuing to respectfully traverse the correctness of the Examiner's position, the applicant has taken note of the Examiner's comment on page 3 stating that "the claims do not require that an initial biofilm deposit be present." Hence, in the interests of advancing prosecution of this case short of going through the appeal process, the applicant has amended the only independent claim to recite a method for reducing existing biofilm deposits, including the step of "reducing said existing biofilm deposits..." Support for this amendment is found at, for example, paragraph 0048, lines 17-19 ("I have discovered that these phenomena also...cause existing biofilms to dissolve") and at, for example, paragraph 0066, lines 15-16 ("inspection showed a reduction of existing deposits within the first three weeks...").

Since this application has been thoroughly searched and none of the cited art discloses or suggests in any way the immersion or use of the invention device for a method to effect the dissolution of

S.N. 10/796,814

Art Unit 1742

existing biofilm deposits, it is respectfully submitted that all prior art rejections have been obviated.

In view of the foregoing, the applicant respectfully requests that the Examiner reconsider all rejections, thereby passing this case to allowance.

No fee is believed to be due with this response. Should there be any unforeseen costs, please charge our Deposit Account No. 17-0055.

Respectfully submitted,

Quarles & Brady Streich Lang LLP



Gavin J. Milczarek-Desai

Reg. No. 45,801

(520) 770-8716 phone  
(520) 770-2235 fax